

REMARKS

Claims 1-37 are currently pending. The Examiner has provided two rejections regarding Claims 11-14. The Applicants kindly thank the Examiner for indicating that Claims 1-10, [15-19],¹ and Claim 32 are allowable.

- I. Claims 11-14 are rejected under 35 USC § 112 ¶ 1 as allegedly failing to comply with the written description requirement.
- II. Claims 11-14 are rejected under 35 USC § 112 ¶ 2 as allegedly being indefinite
- III. Claims 1-10, 15-19, and Claim 32 are free of the art.

I. Claims 11-14 Comply With The Written Description Requirement

The Examiner states that:

The lack of description on the response of the target cell to the test substance in the claimed assays, and the lack of representative species as encompassed by the claims, applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise terms that a skilled artisan would [...] recognize applicants were in possession of the claimed invention.

Office Action pg. 4 ln 19 – pg 5 ln 2. The Applicants disagree because the Examiner relies solely upon *University of California v. Eli Lilly & Co.* (43 USPQ2d 1938) for this conclusion. *Office Action pg 3 ln 19.* The Examiner is respectfully reminded that *Eli Lilly* has been significantly limited by a subsequent case: *Falkner v. Inglis*, 448 F3d 1357, 79 USPQ2d (BNA) 1001 (Fed. Cir. 2006). In view of *Falkner*, the Applicants believe that the Examiner's conclusions are not supported.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have canceled Claims 11-14. This cancellation is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

¹ See, Section III.

II. Claims 11-14 Are Not Indefinite

The Examiner asserts that:

Claims 11-14 are indefinite because of the use of the phrase “thereby determining whether said target cell will respond to the test substance”.

Office Action, pg. 5 ¶ 5. The Applicants disagree because the Examiner is relying on the above rejection based upon Written Description. Nonetheless, the Applicants believe this rejection is moot due to the cancellation of Claim 11-14 for other reasons.

III. Claims 1-10, 15-19, And Claim 32 Are Free Of The Art

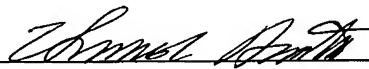
The Applicants gratefully acknowledge the indication of allowability regarding Claims 1-10 and Claim 32. The Examiner is reminded, however, of the recent telephone conversation where it was agreed that Claim 15-19 are also allowable² as they do not contain the disputed 35 USC 112 rejections involving alleged lack of written description and/or indefiniteness. Specifically, Claims 15-19 are all ultimately dependent upon Claim 1, and not Claim 11.

Further, all previously withdrawn Claims 20-31 and 33-37 are now formally canceled. In combination with the above cancellation of Claims 11-14, the Applicants now believe that the present application is in condition for allowance.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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² Note that the Office Action Summary page fails to indicate the Disposition of Claim 15-19.